

**REMARKS**

Claims 1–30 are pending. By this Amendment, claims 1, 11, and 23 are amended.

Reconsideration of the present application is respectfully requested.

Applicants gratefully acknowledge that the Office Action indicates that claims 13, 16, and 17 are allowed.

Support for the feature added to claims 1, 11, and 23 can be found, for example, in paragraph [0022], and Figures 1 and 4–6. The claims are amended to include the position of the blade set. The Examiner indicated that he didn't know how far "proximate" was. This was the first time that this issue was raised by the Examiner. Accordingly, a more defined term has been used in place of the term "proximate" to address this newly raised issue.

**I. The Claims Define Allowable Subject Matter**

The Office Action rejects claims 1–4, 7, 11, 12, 14, 23, and 24 under 35 U.S.C. §102(b) over U.S. Patent No. 3,325,107 to Peterson, and claims 5, 6, 8–10, 15, 18–22, and 25–30 under 35 U.S.C. §103(a) over Peterson. These rejections are respectfully traversed.

Peterson fails to disclose each and every feature of the particle refining apparatus or system as defined in the claims. The amendments to the claims were not presented earlier because the previous Office Action lacked sufficient detail to allow the Applicants to fully understand the Examiner's position. The Final Office Action provides some additional insight to the Examiner's position. Applicants provide the following response under 37 C.F.R. §1.116 to rebut the new issues raised for the first time by the Examiner.

Peterson does not disclose a particle refining apparatus/system that includes a blade set being "positioned to span at least a portion of the wall of the containment device," as recited in

claims 1, 11, and 23. In fact, Peterson fails to disclose a containment device at all. The Office Action does not point to any structure in Peterson that could possibly be construed as a containment device. To expedite prosecution of the pending application, however, Applicants have amended the claims to address the Examiner's concerns with the claim language. Specifically, Applicants have amended the claims to exchange the term "proximate to the containment device" with "positioned to span at least a portion of the wall of the containment device." Applicants respectfully assert that the claims are clearly in condition for allowance.

MPEP § 2143.01 instructs that "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." In the same section it states: "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." The section further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'" See also *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicants respectfully submit that the rejection of the claims that depend from independent claims 1, 11, and 23 are improper in view of MPEP § 2144.03 because the Office Action and applied reference lack evidence of a teaching or suggestion that the features would have been obvious to one of ordinary skill.

Accordingly, Applicants respectfully assert that the rejection under 35 U.S.C. §103 should be withdrawn because the applied reference does not teach or suggest each feature of the pending claims.

As pointed on in MPEP §2131, “[t]o anticipate a claim, the reference must teach every element of the claim.” Thus, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987).” Similarly, MPEP §2143.03 instructs that “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974).”

Therefore, It is respectfully asserted that the rejection under 35 U.S.C. §102 should be withdrawn because the applied reference does not teach each feature of the pending claims.

For at least these reasons, it is respectfully submitted that independent claims 1, 11, and 23 are patentable over the applied reference. The remainder of the claims that depend from independent claims 1, 11, and 23 are likewise patentable over the applied reference for at least the reasons discussed above, as well as for the additional features they recite.

## **II. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is clearly in condition for allowance. Favorable reconsideration and prompt allowance of the pending claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned representative at the telephone number below.

Any fees incident to this Amendment may be charged to Deposit Account No. 08-2665.

DATED this 15<sup>th</sup> day of June, 2006.

Respectfully submitted,



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